

REMARKS

This Amendment is submitted in response to the Examiner's Office Action of August 13, 2004, and is believed to be fully responsive thereto. No new matter has been added to the application. The claims have been amended to clarify certain points raised by the Examiner and are not being narrowed for reasons related to patentability. It is believed that the claims, as presented, define over the art, either when the art is individually considered or even if combined with one another. In the absence of an uncovering by the Examiner of new non-cumulative prior art, this application is believed allowable. Prompt and favorable action is requested and believed warranted.

First, the Examiner indicated that Fig. 7 should be designated as Prior Art. Applicant submits herewith a replacement sheet of drawings (so labelled) with this correction.

Next, Applicant affirms the prior election of the species of Figs. 1-5B entailing Claims 1-7, 10, and 12 and affirms and maintains the traverse of the election requirement. Thirty-five USC § 121 begins as follows: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." (emphasis added). Thus, one should not look to what is disclosed in the specification or shown in the drawings to determine whether one or more inventions are present. Rather, one must look at the claims. Therefore, parsing the invention into Figs. 1-5B and Fig. 6 is inappropriate.

Substantively speaking, the two different versions of the invention provide an annular groove on one element and a corresponding annular flange on a mating element. The two elements are a shaft and a bore. There is no reason why the placing of a groove on a shaft or a flange on a shaft to mate with a corresponding flange/groove in a bore would reasonably require more than one search. Indeed, MPEP § 803 is instructive in this case: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added.) Here, there is extremely limited if any additional burden on the Examiner to examine both versions of the invention.

Moreover, 37 CFR § 1.141 instructs that

more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form...or otherwise include all the limitations of the generic claim.

Applicant hereinabove submits new Claim 13 which is generic to both species and allowable (discussed below). All of the other independent claims (1, 8, and 10-12) include all of the limitations of Claim 13. Thus, Applicant respectfully requests the restriction/election requirement be withdrawn and the entirety of the application be examined.

Turning to the prior art rejections, Claims 1-3, 10, and 12 were rejected under 35 USC § 103(a) as being unpatentable over Taylor in view of Schellin. Claim 4 was rejected under § 103(a) as unpatentable over this art further in view of Brekke. Claims 6 and 7 were rejected as

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unpatentable over Taylor, Schellin, and Barr. Claim 5 was objected to but deemed allowable.

Applicant thanks the Examiner for indicating Claim 5 recites patentable subject matter.

In the above amendments, Applicant has incorporated the subject matter of Claim 5 into all of the independent claims, including the new generic independent Claim 13. All of these claims, and the claims which depend therefrom, should now be allowable. Further, Applicant has amended independent Claims 8 and 11 in the same manner, i.e., incorporating the subject matter of Claim 5 therein. It is recognized that these claims were technically withdrawn, however in the interests of administrative economy, Applicant has offered the above amendment to streamline prosecution of this case and advance the application to allowance. Should the Examiner wish to amend Claims 8 and 11 in an Examiner's Amendment instead of via the above amendment, the undersigned would be readily available to discuss and consent to same.

In view of the foregoing, Applicant submits that Claims 1-4 and 6-13 as amended above recite patentable subject matter and that the application is in condition for allowance. **Applicant respectfully requests a telephonic interview with the Examiner to discuss any further changes that might be deemed necessary.** Prompt and favorable action toward the issuance of a patent is earnestly solicited and believed to be fully warranted. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any

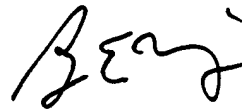
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additional required fee, except for the Issue Fee, for such extension may be charged to Deposit

Account No. **02-2105.**

Dated: November 15, 2004

Respectfully submitted,



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